

REMARKS

In this application, claims 1-20 remain pending. Of these, claims 1, 9, 17 and 18 are independent, with the remaining claims being dependent upon one of these claims. All claims presently stand rejected as purportedly obvious in view of several references. It is respectfully noted that the cited references, whether taken singly or in any combination, fail to teach the elements of any of the independent claims. Because a rejection based on prior art **cannot be sustained** when the cited art fails to teach even one (let alone numerous) of the claim elements, it is respectfully requested that the claims be favorably considered and that the rejections be withdrawn.

The Office Action is difficult to read and understand, but the references themselves are quite clear, and clearly do not teach the limitations for which they are cited. Independent claims 1, 9, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fingerhut (US 6,636,489) in view of Odinak (US 6,487,494). The problems with Fingerhut were noted in the prior response, and continue to be both glaring and troubling.

CLAIMS 1 AND 9

Referring to claim 1, this claim first requires receiving radio station information at the radio module of a mobile vehicle. The Examiner alleges that the Activation Request Packet (Fig. 3) of Fingerhut corresponds to radio station information. Although this is plainly false, there is a bigger problem here. Fingerhut makes very clear that the cited packet is received at the network itself, not at the vehicle, let alone at a radio module within a vehicle. *See* Fingerhut at column 3, lines 55-56 ("During the fourth step ...the initial request for activation ... is formed via an activation-request packet (ARP) The fifth step is to **send the ARP from the device to the network.**")(Emphasis added, reference numbers omitted).

Thus, the rejections cannot be maintained unless the following questions can be answered:

- In what possible sense does the "Activation Request Packet" comprise "radio station information?" Figure 3 shows only 5 fields for the ARP – which one of these fields contains the radio station information?
- In what way would a network such as network 12 be deemed a "radio module" within a mobile vehicle as required by the claim?
- Fingerhut's "device" sounds very much like a cell phone (screen, keypad, etc.), and yet the Examiner has deemed the device to be a "radio station." What rationale supports the Examiner's view that a cell phone can be equated to a radio station?

Turning to the next limitation of claim 1, the claim requires "detecting an initiation command received from the radio module user interface." The Examiner cites the network processing of the ARP as being the required detection of an initiation command from the radio module user interface. *See* action at page 2. However, the ARP was received from the "device." Thus, at this point, the Examiner is now stating that the device that was previously deemed to be a radio station is now just the opposite, e.g., a radio module of a mobile vehicle, having a user interface. (The action later admits that Fingerhut omits any mention of a user interface; page 3). To the extent it is even understood, this position seems entirely illogical, and clarification is requested via the following questions:

- What is the "initiation request" in Fingerhut? Is it a field of the ARP? Is it data derived based on the ARP?
- Where was this initiation request received from? If received from the device, is the examiner now asserting that Fingerhut's cell phone device is both a radio station and a radio module within a mobile vehicle?

Claim 1 next requires "providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command." The Examiner has indicated that the transmission of the ARP response packet back to the device of Fingerhut meets this limitation. However, since the device is already taken for several prior limitations, where is the required "telematics unit?" The action says that the network and the device together are a telematics unit. *See* page 3. But the device has already been deemed to be a

radio station. An answer to the following would greatly clarify the Office's position in this regard:

- Exactly which element (if any) of Fingerhut is the Examiner citing as the required radio module?
- Exactly which element of Fingerhut is the Examiner citing as the required telematics unit?

Finally, on page 3, the Examiner notes that Fingerhut fails to teach a radio module having a user interface. If Fingerhut fails to teach a radio module, then it necessarily also fails to teach receiving radio station information *at* the radio module, detecting an initiation command received *from* the radio module and providing the radio station information *from* the radio module *to* the telematics unit.

Of course, a combination of references cannot make obvious a claim unless each and every element of the claim appears in one reference or the other. Where, as here, every single limitation of the claim is missing from all of the references, a prima facie case of obviousness cannot be made. It will be appreciated that the above comments apply equally to claim 9.

CLAIM 18

Claim 18 is similar to claims 1 and 9, but further requires that the radio station information is received via a sub-carrier band of a radio signal. The rejection of claim 18 is similar to that of claims 1 and 9, and is traversed for similar reasons. In addition, the rejection of claim 18 includes further subject matter that cannot be understood.

The rejection refers to "interfaces" of Figure 4 of Fingerhut, but no such interfaces are included in the figure. *Clarification is requested as to the identity of the cited "interfaces."*

The rejection also assumes without any cited support that Fingerhut operates via sub-carrier bands. *See* Action at page 5. Fingerhut does not mention sub-bands at any point. *Please identify in Fingerhut the basis, if any, for the assertion that Fingerhut teaches sub-band operation.*

CLAIM 17

The remarks above apply with even greater force with respect to claim 17. Moreover, this claim (reproduced below) is plainly drafted in "means-plus-function" format pursuant to 35 U.S.C. §112¶6 ("means for receiving radio station information"; "means for detecting an initiation command"; and "means for providing the radio station information"):

A system for operating a telematics unit within a mobile vehicle having a radio module comprising a radio module user interface, the system comprising:
means for receiving radio station information at the radio module;
means for detecting an initiation command received from the radio module user interface; and
means for providing the radio station information from the radio module to the telematics unit responsive to the detected initiation command.

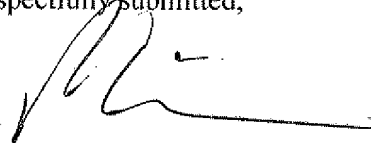
As such, MPEP §2181 expressly requires that the claim be treated according to §112¶6, or that detailed reasons be given as to why such limitations were not treated as means-plus-function limitations. ("[T]he examiner **must** include a statement in the Office action explaining the reasons why a claim limitation which uses the phrase 'means for' or 'step for' is not being treated under 35 U.S.C. §112, sixth paragraph.")(Emphasis added).

Thus, claim 17 must be treated according to §112¶6 or a detailed analysis must be provided as to why such treatment was not applicable in this case. As such, the Examiner has violated MPEP §2181 and has not presented a prima facie case of obviousness regarding claim 17. If the present rejection of claim 17 is maintained, applicant respectfully requests that the Examiner comply with MPEP §2181 in the next action.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance, and favorable reconsideration of all rejections is requested. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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